

REMARKS

The Application has been reviewed in light of the Final Office Action mailed August 19, 2004. At the time of the Final Office Action, Claims 5-17, 35-40, 42, 47, and 55-72 were pending in this Application. Applicant previously canceled Claims 1-4, 18-34, 41, 43-46, and 48-54 without prejudice or disclaimer. Applicant presently cancels Claim 35 without prejudice or disclaimer. Claims 5-17, 35-40, 42, and 70-72 were rejected under 35 U.S.C. §103(a). Claims 47 and 55-69 were allowed. Applicant has amended Claims 5 and 70. No new matter is presented by these amendments. Applicant respectfully requests reconsideration and favorable action in this case.

Claim Rejections Under 35 U.S.C. §103

Claims 5-17, 35-40, and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,474,763 issued to Lubowe ("Lubowe") in view of foreign patent publication WO 96/01617 filed by Li et al. (hereinafter "Li").

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). A *prima facie* case of obviousness has not been made. Nonetheless, Claims 5 and 70 have been amended to more distinctly claim the subject matter of the invention. Amended independent Claims 5 and 70 now require the nucleic acids to comprise more methyl-groups than naturally occurring nucleic acids, like those described in Li. The Examiner notes, "Li teaches a sunscreen formulation comprising nucleic acids...extracted from natural sources" which *naturally* "comprise one or more R-group substitutions including methylation."

Consequently, the Applicant respectfully submits that Li does not teach and/or suggest the further methylation of natural occurring nucleic acids which subsequently results in nucleic acids having more methyl-group substitutions than naturally occurring nucleic acids. Note, the specification of the present application specifically teaches the further methylation of naturally occurring nucleic acids. Applicant submits the claims are now in condition for allowance and requests favorable action thereon.

Claim Rejections Under 35 U.S.C. §102

Claims 70-72 were rejected under 35 U.S.C. §102(b) as being anticipated by Li. Claims 70-72 have been amended to distinctly claim the subject matter of the claimed invention, *i.e.*, nucleic acids comprising more methyl-group substitutions than naturally occurring nucleic acids. Claims 70-72 would appear to be in condition for allowance.

Allowable Subject Matter

Claims 47 and 55-69 are allowed.

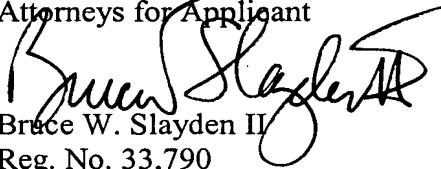
CONCLUSION

In light of the above amendments and remarks Applicant respectfully submits that the Application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this Application, the Examiner is invited to contact the attorney of record by telephone or facsimile.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0383 of Baker Botts L.L.P. in order to effectuate this filing.

Respectfully submitted,

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